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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BERNHARDT, EMILY B

ART UNIT PAPER NUMBER

1624

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,483

Applicant(s)

DAX ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5,8,9,12 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-5,8,9,12 and 17-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A review of the instant file indicates that no restriction has been made yet parent was restricted with a subsequent election of Group III subject matter which was eventually allowed. Subject matter present in pending claims (2-5, 8,9,12 and 17-19) is not limited to a particular group but rather covers all groups set forth in parent including allowed subject matter. Thus, consistent with restriction requirement set out in parent (although it has been compacted in part to accommodate species claims 3-5 and 8-9 into 1 group) the following requirement is being made herein.

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 2-5,8,9 and 17-19, drawn to compounds, compositions and uses where R₂=pyridyl and L= piperidino-containing and piperazino links, classified in class 546, subclass 20,194;class 544, subclass 360; class 514 subclasses 253.01,278, 318.
- II. Claims 2, and 17-19, drawn to compounds, compositions and uses where R₂= pyridyl and L= remaining divalent groups not provided for by I, classified in class 546, subclasses such as 279.1,333; class 514 subclasses such as 343, 357.

III. Claims 2,12,17-19, drawn to compounds, compositions and uses where B1/B2 form a 5- or 6-membered ring with 1 or 2 methylenes and R2 and L are other groups not provided for by I-II, classified in class 544, subclass 392,393,etc; class 546, subclasses 20,199; class 564 subclasses such as 91,92; class 514 subclasses 255.03, 278,322, 604.

IV. Claims 2 and 17-19, drawn to compounds, compositions and uses where B2=H and R2 and L are other groups not provided for by I-II, classified in classes 544,546,548,549,562,564, subclasses various as determined by the particular nature of R and L and Z embodiments; class 514 various subclasses.

If Group III or IV is elected applicants must further choose L and R2 values selected from the following groups:

- A. L= alkylene, alkenylene, alkynylene, arylalkylene;
- B. L= alpha-aminoalkylene, cycloalkylene, cycloalkylC1-C4alkylene;
- C. L= all piperidino links (3), piperazino link, pyrrolidino link;

AND FOR R2

- A. R2= H, alkyl, substituted alkyl, halo, phenyl, naphthyl- both unsubstituted and substituted;

B. heteroaryl, heterocycloalkyl.

In addition to an election of one of the above groups applicants must also elect a single species embrative of that group to which claim(s) may be limited should generic claims be found not allowable.

The inventions are distinct, each from the other because of the following reasons:


Compounds of I-IV are drawn to structurally dissimilar compounds as there is no common core. As a result they are separately classified, and/or require separate Chemical Abstract online searches. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group. Different issues of patentability would be expected in view of the structural dissimilarity for compounds of I vs II vs III vs IV vs V as a whole. Applicants' numerous provisos appear to be necessitated at least in part to avoidance of literal overlap with commonly assigned patent, US'354 and WO'682, previously applied.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is (571) 272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Emily Bernhardt
Primary Examiner
Art Unit 1624